

REMARKS

Claims 1-30 and 35 are pending. Applicants appreciate the Examiner's consideration of references cited in the PTO-1449 forms received by the Office on October 6, 2003 and October 14, 2003 as evidenced by the Examiner's initials next to each reference thereon. Applicants note that the Examiner inadvertently failed to sign and date the PTO-1449 forms, however. Applicants respectfully request that the Examiner forward signed and dated PTO-1449 forms to Applicants with the next communication from the Office.

Applicants address the concerns of the Examiner in the order in which they appear in the Action.

I. § 103 Rejection

Claims 1-30 and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,318,603 to Burt (Burt) in view of U.S. Patent No. 5,772,086 to Bryant, et al. As an initial matter, Applicants note that U.S. Patent No. 5,772,086 is to Krafft and that the previously cited U.S. Patent No. 5,772,085 is to Bryant, et al. For the purposes of responding to the outstanding rejection, Applicants have assumed that the present claims have been rejected over Burt in view of U.S. Patent No. 5,772,085 to Bryant, et al. (Bryant). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.¹ M.P.E.P. § 2142.

Applicants respectfully submit that the Patent Office has not established a *prima facie* case of obviousness for at least the reason that the Patent Office has not established some

¹ Because all three criteria must be met in order to establish a *prima facie* case of obviousness, and the criterion that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings has not been met, Applicants address this criterion without discussion of the other two criteria, namely whether there is a reasonable expectation of success, and whether the prior art reference (or references when combined) teaches or suggests all the claim limitations. Applicant's decision not to discuss these other two criteria is in no

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Burt in view of Bryant or to combine the teachings of Burt with Bryant to arrive at the claimed invention.

The Action focuses on the aerosol valve as seen in Figs. 13 and 19 of Bryant and notes that these illustrated valves have sealing rings seen in Figs. 2a-2g. Applicants note that the upper and lower seals (104 and 106) in Fig. 13 and the seal element (668) in Fig. 19 are positioned on the valve stem with the sealing surface at its outer sealing face. Moreover, the sealing elements described in Figs. 2a-2g are also designed to be positioned on the valve stem with the sealing surface at their outer sealing faces. In contrast, the seals (9 and 12) of Burt are not positioned on the valve stem, but are instead positioned such that the valve stem slides through the seals at their inner sealing face. While Bryant proposes seals having cross-sections such as those described in Figs. 2a-2g to be positioned on the valve stem and present an outer sealing face, Bryant does not disclose or suggest modifying such seals so that they could be used to replace the seals (9 and 12) of Burt.

In fact, many of the valves proposed by Bryant have seals, such as the seals (9 and 12) of Burt, that are positioned such that the valve stem slides through their inner sealing face. For example, see Fig. 5, seal 24; Fig. 7, seal 34; Fig. 8, seals 52, 60, and 70; Fig. 15, seal 418 and seal 408; Fig. 17, seal 616; and Fig. 25, seal 932. In each of these instances, Bryant shows a seal with a cross-section similar to the seal in Burt. Bryant does not show any seals having cross-sections such as those described in Figs. 2a-2g positioned within a valve such that the valve stem slides through the inner sealing face of the seal. Furthermore, Bryant does not provide the motivation for one to modify the seals having cross-sections such as those described in Figs. 2a-2g so that they could be used to replace the seals (9 and 12) of Burt.

For at least the foregoing reasons, there is no motivation to combine the teachings of Burt with the teachings of Bryant to arrive at the claimed invention. Accordingly, Applicants respectfully submit that claims 1-30 and 35 are patentable over Burt in view of Bryant and request that these rejections be withdrawn.

II. Conclusion


The concerns of the Examiner addressed in full, Applicant respectfully requests the withdrawal of all outstanding objections and rejections, and the issuance of a Notice of

way an acquiescence that these criteria have been proven by the Patent Office, and Applicant expressly reserves the right to address one or both of these criteria in future responses, should the need arise.

Serial No. 09/937,232
Attorney Docket No. PG3654U/Sv

Allowance forthwith. Applicant encourages the Examiner to direct any questions to the undersigned, who may be contacted at (919) 483-9024.

Respectfully submitted:


J. Michael Strickland
Attorney for Applicant
Reg. No. 47,115

Date: September 18, 2006
GlennSmithKline Inc.
Corporate Intellectual Property
Five Moore Drive, P.O. Box 13398
Research Triangle Park, NC 27709
Tel. (919) 483-9024
Fax. (919) 483-7988